

REMARKS**I. Status of the Claims:**

Upon entry of this Amendment, claims 1-8, 10-25, and 28-34 will be pending. Claims 1, 8, 19, 25, 28, 30, 31, and 33 have been amended, and claims 9, 26 and 27 have been canceled without prejudice or disclaimer. These changes are believed to introduce no new matter. Accordingly, entry and consideration of this Amendment are respectfully requested.

II. Rejections under 35 U.S.C. §112:

Claims 8, 19, and 30 are rejected under 35 U.S.C. § 112, second paragraph. In particular, claims 8 and 19 are rejected for allegedly omitting essential steps, while claim 30 is rejected for a claim term having insufficient antecedent basis. These claims have been amended to overcome these rejections. Accordingly, Applicants request that these rejections be withdrawn.

III. Rejections under 35 U.S.C. §103

The Examiner raises two different rejections under 35 U.S.C. §103. Each of these rejections involves U.S. Patent No. 6,014,090 to Rosen et al. (“Rosen”). For instance, claims 1-7, and 9 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,014,090 to Rosen et al. (“Rosen”) and “UDDI Technical White Paper”, while claims 10-29 and 31-34 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Rosen in view of “UDDI: an XML web service.” Applicants respectfully traverse these rejections for at least the following reasons.

The USPTO Manual of Patent Examining Procedure (“MPEP”) states:

To establish a *prima facie* of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP §2143 (Rev. 2, May 2004).

In accordance with the above criteria, MPEP §2141 states that “references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.” The Federal Circuit characterizes this impermissible activity by stating that “combining prior art references without evidence of such a suggestion, motivation, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patent patentability – the essence of hindsight.” In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999). Moreover, the Federal Circuit has stated that “the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” Id.

In combining the applied references, the Examiner merely states, such as on page 4 of the Office Action that “it would have been obvious to one of ordinary skill at the time of the invention to add the UDDI web service . . . in order to provide the advantages of the UDDI protocol.” However, Applicants assert that this rationale is based on impermissible hindsight because it relies completely on the claims of the present application and nothing suggested elsewhere. In other words, it appears that the Examiner has used the claims of the present application as a blueprint for piecing the references together.

In addition, technical differences exist between the claims of the present application and the applied references. For instance, independent claims 1, 25, 31, and 33 have been amended to recite features involving the caching of content. These features were previously recited in dependent claims 9 and 27. In particular, claim 9 recites “wherein the server caches files accessed from web sites, for selective forwarding to the user’s wireless device.” Also, claim 27 recites “storing the filtered documents and the sorted list in a cache for later, selective accessing by the user.”

On pages 7 and 17 of the Office Action, the Examiner asserts that Rosen discloses these caching features at columns 4 and 6. Applicants respectfully disagree. Column 4 of Rosen, as relied upon by the Examiner, merely discloses the storage of content in its native original locations (i.e., in a resource server). This is not caching, as recited in claims 9 and 27. Moreover, the passage relied on by the Examiner in column 6 of Rosen merely discloses the storage of addresses, not the caching of content.

Also, dependent claim 24 recites a replay feature in which updated geographical information is used. The Examiner asserts on page 14 of the Office Action that Rosen discloses such a replaying feature at column 6, lines 40-45. Applicants respectfully disagree with this assertion. This passage in Rosen addresses the dynamic nature of information from the perspective of a resource server. However, this passage does not disclose or suggest replay, as recited in claim 24. Moreover, Rosen is silent with regard to the use of updated geographical information.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 4208-4010.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4208-4010.

Respectfully submitted,
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